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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/776,851 | 02/11/2004 | Uwe Jurgen Becker | CM2687MQ | 3886 |
| 27752 | 7590 | 12/07/2005 | EXAMINER | |
| THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION WINTON HILL TECHNICAL CENTER - BOX 161 6110 CENTER HILL AVENUE CINCINNATI, OH 45224 | | | BOGART, MICHAEL G | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3761 | |

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/776,851 | Applicant(s) BECKER ET AL. | |
| | Examiner Michael G. Bogart | Art Unit 3761 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/04, 7/04, 10/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification/Drawings

The drawings are objected to because they include the following drawings(s) not mentioned in the description: Fig. 8. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the drawings(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claims 4 and 11 are objected to because of the following informalities: In claim 4, "fibourised" appears to be a typographical error. In claim 11, line one, after layers, "of" should be replaced with --or--. Appropriate correction is required.

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. § 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the claim is defined by an absorbent core that achieves a absorbent core achieves a wet immobilization of more than about 50% according to the Wet Immobilization Test described in the specification.

Claims merely setting forth physical characteristics desired in article, and not setting forth specific compositions which would meet such characteristics, are invalid as vague, indefinite, and functional since they cover any conceivable combination of ingredients either presently existing or which might be discovered in future and which would impart desired characteristics; thus, expression "a liquefiable substance having a liquefaction temperature from about 40°C. to about 300°C. and being compatible with the ingredients in the powdered detergent composition" is too broad and indefinite since it purports to cover everything which will perform the desired functions regardless of its composition, and, in effect, recites compounds by what it is desired that they do rather than what they are; expression also is too broad since it appears to read upon materials that could not possibly be used to accomplish purposes intended. *Ex parte Slob* (Bd. Pat. App. & Int. 1968) 157 USPQ 172; *Austenall Laboratories, Incorporated v. Nobilium Processing Company of Chicago et al.*, 115 USPQ 44 (D.C. N. Ill. 1957).

Claims 2-12 are indefinite because they depend from an indefinite claim.

Claim Rejections – 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6 and 8-11 are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Tanzer *et al.* (US 5,425,725 A).

Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. §§ 102 and 103, expressed as a 102/103 rejection. “There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. § 103 and for anticipation under 35 U.S.C. § 102.” *In re Best*, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA 1977). This same rationale should also apply to product, apparatus, and process claims claimed in terms of function, property or characteristic. Therefore, a 35 U.S.C. § 102/103 rejection is appropriate for these types of claims as well as for composition claims.

“[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.” *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, *supra*.

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There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003).

“[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency’ under 35 U.S.C. § 102, on prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same...[footnote omitted].” The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, supra). MPEP § 2112.

Regarding claim 1, Tanzer *et al.* teach an absorbent core (112, 120) useful for an absorbent article comprising a substrate layer (98) and absorbent material (110), said absorbent material (110) comprising an absorbent polymer material and *optionally* an absorbent fibrous material, said absorbent fibrous material not representing more than about 20 % of the weight of absorbent polymer material, wherein said absorbent material (110) is immobilized (trapped in pocket regions (108)) when wet such that said absorbent core (112, 120) achieves a wet immobilization of more than about 50% according to the Wet Immobilization Test (see figures 6 and 7, below).

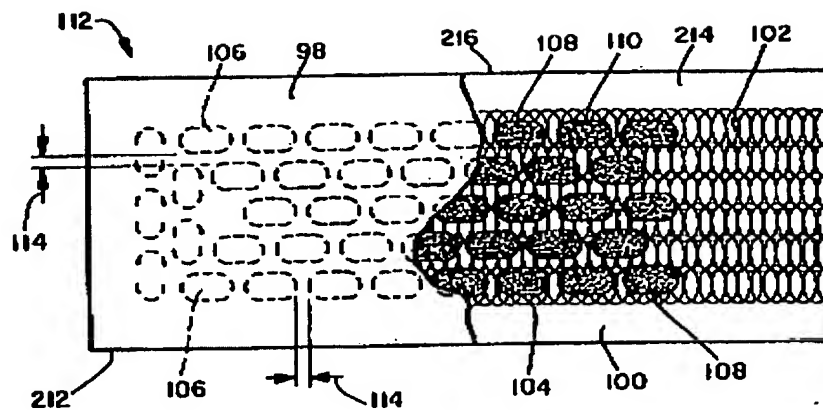


FIG. 6

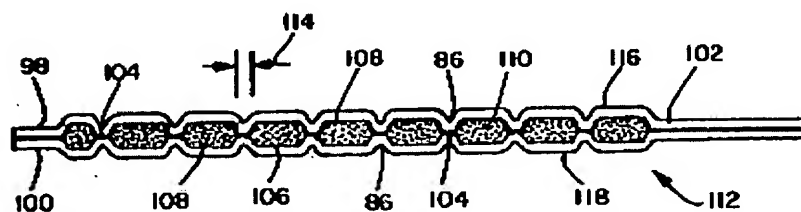


FIG. 7

Regarding claim 2 Tanzer *et al.* teach a thermoplastic material (100), which contacts said absorbent polymer material (110)(col. 13, lines 1-8).

Regarding claim 3, Tanzer *et al.* teach that the thermoplastic material (100) is a hot melt adhesive (col. 13, lines 1-8).

Regarding claim 4, Tanzer *et al.* teach that said thermoplastic material (100) is fiberized or fibrous (col. 13, lines 1-8).

Regarding claim 5, Tanzer *et al.* teach that said thermoplastic material (100) substantially immobilizes said absorbent polymers (110).

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Regarding claim 6, Tanzer *et al.* teaches the absorbent core (112, 120) having a distribution of absorbent polymer material wherein the distribution of absorbent polymer material is profiled (col. 19, lines 53-col. 22, line 29).

Regarding claim 8, Tanzer *et al.* teach at least two substrate layers (98, 100).

Regarding claim 9, Tanzer *et al.* teach that one of the substrate layers (98, 100) is a hydrophilic non-woven (e.g., Hydrofil ®)(col. 13, lines 1-8; col. 36, lines 26-39).

Regarding claim 10, Tanzer *et al.* teach at least one substrate layer (98) and at least one cover layer (28).

Regarding claim 11, Tanzer *et al.* teach that one of the substrate layer (98) or cover layer (28) is a hydrophilic non-woven (e.g., Hydrofil ®)(col. 13, lines 1-8; col. 36, lines 26-39).

In an alternative interpretation of the invention for anticipation under 35 USC § 102, in order for someone to actually determine whether or not a particular absorbent core meets the limitations of the instantly claimed invention requires subjecting such a core to the Wet Immobilization Test, making claim 1 a product-by-process claim.

Product-by-process claims are not limited to the manipulations of the steps, only the structure implied by the steps. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). MPEP § 2113.

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Regarding the alternative rejection of claims 1-11 as being unpatentable under 35 USC § 103, generally, differences in test characteristics will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such test characteristic is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955).

A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Regarding claims 1-12, the benefits of immobilizing the inner materials of a diaper when soaked with urine would have been known prior to applying a test (e.g., prevention the absorbent materials from bunching up excessively in discrete areas of the diaper causing discomfort to a wearer, or aesthetic considerations), making these values result-effective variables. One of ordinary skill in the art would have recognized that increasing the wet immobilization properties of the absorbent material in a diaper or similar article would increase its resistance to moving around between top and back sheets and would prevent the absorbent from bunching up uncomfortably. MPEP § 2144.04.

Claims 7 and 12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tanzer *et al.*

Tanzer *et al.* do not teach the specific dimensions of the crotch width or the specific basis weight of absorbent material.

Mere changes in size alone are not sufficient to patentably distinguish an invention over the prior art. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. MPEP § 2144.04.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bogart whose telephone number is (571) 272-4933.

In the event the examiner is not available, the Examiner's supervisor, Tatyana Zalukaeva may be reached at phone number (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for formal communications. For informal communications, the direct fax to the Examiner is (571) 273-4933.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Bogart
2 December 2005

TATYANA ZALUKAEVA
SUPERVISOR, PRIMARY EXAMINER

